

Patent
Attorney Docket: AUS920010175US1
(IBM/0004)
Confirmation No. 8858

REMARKS

Applicant thanks the Examiner for taking the time to discuss the pending office action prior to filing this Response. The remarks that follow were included in the telephone conference held with the Examiner.

Claims 1-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,616,038 issued to Olschafskie, *et al.*, in view of the U.S. Pub. No. 2001/0034738 of Cantwell, *et al.*

Olschafskie discloses methods and devices that provide a fast, reliable way to store, record, and reproduce written texts useful for students and others relying on prior authority, such as attorneys, to simply scan a spatial symbology corresponding to important subject matter and have any part of it stored for later use or reproduced instantaneously in electronic or physical form. (Olschafskie, col. 4, ln. 60-64). Olschafskie further discloses that the special symbology may be located parallel to the text on the page, in a related location such as a footnote, or embedded within the graphic symbols themselves. (Olschafskie, col. 4, ln. 22-25).

Olschafskie further discloses that the spatial symbology may be used in numerous ways to identify a variety of information such as referencing portions of the text or passages from a document and as a message relevant to the text in which it is embedded. (Olschafskie, col. 3, ln. 22-25).

Cantwell discloses methods and devices for agenda management by government bodies who are, by law, required to generate and publish agendas containing information concerning the items they will consider. (Cantwell, ¶3). Cantwell discloses that paper agendas may be scanned into an electronic document management system where they are stored and indexed in databases for subsequent search and retrieval; that the scanned documents may be routed either manually or automatically to all parties involved in the approval process of the documents and to track their status; that an output management system is used to publish the auto-filled templates which include meeting agendas and associated minutes for use by an organization and members of the public. (Cantwell, Abstract). The problem sought to be solved by Cantwell is the timely publishing of agendas of meeting and of meeting minutes of governmental bodies. (Cantwell, ¶ 3).

Patent
Attorney Docket: AUS920010175US1
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Applicant claims methods and devices for editing a document offline by adding editing marks to an offline document and then automatically executing those editing marks to generate an edited copy of the document. Specifically, Applicant claims, *inter alia*, identifying one or more editing instructions and executing each of the one or more editing instructions to generate a subsequent version of a document or to otherwise modify one or more text segments. (Claims 1, 9, 14, 15 and 23). Applicant seeks to improve productivity by providing methods of modifying documents that are online according to the editing marks that have been inserted into an offline version of the document by an editor. (Specification, p. 2, ln. 6-14).

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 291 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Additionally, the Examiner must provide a basis for combining or modifying the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Evidence of a suggestion, teaching or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996)

Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented because the prior art references cited by the Examiner do not teach or suggest all the limitations claimed by Applicant and further, because there is no basis for combining or modifying the references cited by the Examiner. First, neither of the cited prior art references teaches nor discloses Applicant's claimed limitation "identifying one or more editing instructions." While Olschafskie discloses that spatial symbology may be scanned from a document, Olschafskie does not disclose that the symbology represents *editing instructions*, which is the limitation claimed by Applicant. Olschafskie teaches that the symbology is inserted into the text to provide a fast, reliable way to

Patent
Attorney Docket: AUS920010175US1
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Confirmation No. 8858

store, record and reproduce written text. (Olschafskie, col. 4, ln. 56-59). Olschafskie does not disclose that the spatial symbology may be used as editing instructions. Olschafskie discloses that the information may be written to a document in a word processor, viewed on a computer monitor, printed, written to a pre-existing file or to a file created by the processor. (Olschafskie, col. 4, ln. 36-42). In fact, Olschafskie discloses that after the information has been written to a pre-existing file or to a file created by the processor, the text may be further manipulated in a variety of ways, including stored, viewed, printed, annotated or edited. (Olschafskie, col. 4, ln. 55-59). Therefore, the only reference made by Olschafskie to editing is that a person may edit a document, as on a word processor, but not that the computer processor edits the document based upon editing instructions, which is the limitation claimed by Applicant. In fact, Olschafskie discloses, suggests or teaches only that the spatial symbology contains *information*, not *instructions* to be executed by the processor.

Secondly, neither of the cited prior art references teaches nor suggests executing each of the one or more editing instructions. Olschafskie merely discloses a method and device for copying research information from one offline document to an electronic file by scanning the document, which also contains spatial symbology that relates to the source of the scanned document or other information regarding the scanned text, such as page number and web site source of the scanned text. Olschafskie does not teach or suggest that the spatial symbology may be instructions to be processed, only that the special symbology contains information that may be read and stored by the processor but not as an *instruction* for the processor to *execute*. There is no teaching or suggestion of *executing* editing instructions, a limitation claimed by Applicant.

Thirdly, Cantwell does not disclose generating a subsequent version of the document or modification of the text by executing the editing instructions, which is a limitation claimed by Applicant. The Examiner states that Cantwell discloses that documents may be processed through an approval process that is automatically or manually tracked, stored, and assigned a URL or hyperlink for retrieval by others. (Office Action, p. 3, ln. 14-21). Applicant respectfully asserts that this citation of prior art does not teach or suggest generating a subsequent version of the document or modifying of the text by executing the editing instructions, which is the limitation claimed by

Patent
Attorney Docket: AUS920010175US1
(IBM/0004)
Confirmation No. 8858

Applicant.

Therefore, because the cited prior art references do not suggest or teach each and every limitation claimed by the Applicant, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. The cited prior art references fail to disclose Applicant's claimed limitations of identifying one or more editing instructions, executing each of the one or more editing instruction, and generating a subsequent version of the document or modification of the text by executing the editing instructions. Reconsideration and withdrawal of the rejection of independent claims 1, 9, 14, 15 and 23 is respectfully requested as well as the withdrawal of the rejection of all other claims depending from these independent claims.

Furthermore, Applicant respectfully asserts that a justification for a motivation to combine or modify the cited prior art references has not been provided with evidence of a suggestion, teaching or motivation to combine references. As the courts have stated, as cited *supra*, such evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. The Examiner has stated that one of ordinary skill in the art would be motivated to combine or modify Olschafskie and Cantwell to achieve the benefit of rapidly and automatically modifying a large number of offline documents and reducing the labor intensive work of representing the subsequent online documents. (Office Action, p. 4, ln. 3-9). The Examiner cites Cantwell as evidence to support this justification, the cited portion is as follows:

Conventional agenda processes are typically paper-based. Governing bodies and other organizations have found it difficult to *route and track* the often overwhelming number of hard-copy documents. Since these documents must be *shared amongst many people* prior to their inclusion in an agenda, *managing* the documents becomes an important task. *Manually managing such a large number of hard-copy documents* can be difficult and often results in delays and/or lost or mis-routed information. Moreover, *accessing the information* contained in the documents created and used during the agenda process typically requires *labor intensive searches* since the documents may be archived on off-line media such as microfiche or hard-copy files.

Cantwell, ¶4, emphasis added.

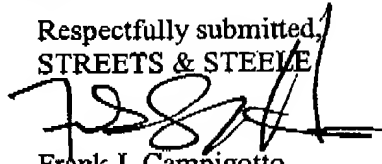
Patent
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In that portion of Cantwell cited by the Examiner as evidence to support the justification to modify the cited prior art references, there is no mention of editing documents or that editing documents may be a problem. Instead, the problem sought to be solved by Cantwell is routing and tracking a large number of documents that must be shared by many people and accessing the information contained in the documents that typically requires labor intensive searching. There is no mention of editing documents, only of managing the documents and making them available on line to the public or others as required by law.

Cantwell does not provide any suggestion or motivation to combine with or modify Olschafskie. There has been no presentation of evidence flowing from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved to support the modification. Therefore, a *prima facie* case of obviousness has not been established. Reconsideration and withdrawal of the rejection of independent claims 1, 9, 14, 15 and 23 is respectfully requested as well as the withdrawal of the rejection of all other claims depending from these independent claims.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0004 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,
STREETS & STEELE



Frank J. Campigotto
Attorney for Applicant
Registration No. 48,130
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713) 939-9444
Customer No. 24945